

### **REMARKS**

Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and following remarks. In the Office Action, mailed December 15, 2003, the Examiner objected to the specification and rejected claims 1-3, 6, 8 and 10-24. Applicant has amended the Abstract of the specification, amended claims 1, 8 and 21 to further clarify the invention and deleted claim 22. Following entry of these amendments, claims 1-3, 6, 8, 10-21, 23 and 24 will be pending in the application.

#### ***Specification Objection***

In the Office Action, the Examiner objected to the Abstract of the specification, pursuant to MPEP §608.01(b), because of inappropriate Abstract phraseology. Applicant has amended the Abstract to correct this informality and respectfully requests withdrawal of the specification objection.

#### ***Claim Rejections under 35 U.S.C. § 112 (First and Second Paragraph)***

##### **Claims 11-20 (§112, first paragraph)**

In the Office Action, the Examiner rejected "claims 11, 16, and the intervening claims" (presumably dependent claims 12-15, which ultimately depend from independent claim 11, and dependent claims 17-20, which ultimately depend from independent claim 16) under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Applicant respectfully traverses the rejections of claims 11-20.

A rejection under 35 U.S.C. §112, first paragraph, is not appropriate when "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

In the Office Action, the Examiner contends that independent claims 11 and 16 contain subject matter that "was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (See, Office Action, p. 3, para. 3.1). Specifically, the Examiner states that the first step of independent claims 11 and 16 "incorporates as new matter 'a medium having an authorized user having a face, the image being free of the face of the authorized

user” and thus alleges that “applicant fails to describe a photograph having an image of an object and a user face as described ... in the claims” (See, Office Action, p. 3, para. 3.1).

First, Applicant respectfully notes that the Examiner has misinterpreted the first elements of claims 11 and 16. These claims do not require, as stated by the Examiner, “a photograph having an image of an object and a user face.” Rather, the first elements of independent claims 11 and 16, respectively, require:

a medium having an image of an object, the medium having an authorized user, the authorized user having a face, the image being free of the face of the authorized user,

and

forming an image of an object on a medium, the medium having an authorized user, the authorized user having a face, the image being free of an image of the face of the authorized user.

The proper interpretation of these elements is that the medium only has an image of an object, where the image is not the face of the authorized user. These elements do not require that the medium include an image of an object and a user face, as stated by the Examiner. Following the literal flow of these elements: the medium has an image of an object, the medium also has an authorized user (i.e., a person authorized to use the medium), the authorized user has a face (as most people do), and the image of the object that is on the medium is free of (i.e., not) an image of the face of the authorized user.

Further, with the proper interpretation of the rejected elements of independent claims 11 and 16 in mind, Applicant asserts that those skilled in the relevant art would understand that, at the time the application was filed, Applicant had possession of the claimed invention of rejected claims 11-20. First, the specification is replete with disclosure of a medium having an image of an object (See, for example, Application, p. 2, first para.). Second, the specification discloses the authorized user concept, for example, at p. 2, second para. and at p. 3, last para. Third, it is an inherent characteristic of a person, the authorized user, to have a face. Finally, nowhere does Applicant disclose using a photograph of the user’s face as the image. Rather, Applicant discloses using a polished gemstones or cut pieces of granite as the image (See, Application p. 4, last partial para.).

Applicant respectfully submits that the specification fully defines and supports the properly interpreted claims 11-20. Thus, for at least the foregoing reasons, the §112, first paragraph,

rejections of claims 11-20 should be withdrawn.

Claims 1-3 and 6 (§112, second paragraph)

In the Office Action, the Examiner rejected “claim 1 and the intervening claims” (presumably dependent claims 2, 3 and 6, which ultimately depend from independent claim 1) under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant respectfully traverses the rejections of claims 1-3 and 6.

Specifically, in the Office Action, the Examiner noted that the “program” mentioned in claim 1 renders it indefinite because it is unclear whether the program in question refers to a hardware or software program. Claim 1, as amended, uses the word “program” in the third limitation, as follows:

a software program that is adapted to convert the digital representation of the security photograph into an encrypted passkey that is stored within the encrypting security device, and further adapted to automatically match the encrypted passkey to the digital representation of the security photograph for allowing access to an associated apparatus.

As can be seen from this limitation of amended claim 1, there is no longer an indefinite use of the word “program.” Thus, the Examiner’s rejection of claim 1 has been rendered moot.

For at least the foregoing reasons, the §112, second paragraph, rejections of amended independent claim 1 and non-amended, dependent claims 2, 3 and 6 should be withdrawn.

*Claim Rejections under 35 U.S.C. §103(a)*

In the Office Action, the Examiner rejected claims 1-3, 6, 8 and 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,581,634 to Williams (hereinafter “Williams”) in view of U.S. Patent No. 5,932,119 to Kaplan, et al. (hereinafter “Kaplan”). Further, the Examiner rejected claims 21-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,993,068 to Piosenka, et al. (hereinafter “Piosenka”) in view of Kaplan. Applicant respectfully traverses the rejections of claims 1-3, 6, 8, 10 and 21-24 and notes for subsequent reference the following standards for a proper §103(a) rejection.

A §103(a), or obviousness, rejection is proper only when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” 35 U.S.C. §103(a). The Examiner must make out a *prima facie* case for obviousness. The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The *en banc* Federal Circuit has held that “structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness.” *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (Fed. Cir. 1990).

For at least the reasons stated below, Applicant asserts that the cited art fails to describe or suggest the subject matter as a whole of Applicant’s claimed invention and, therefore, that Applicant’s rejected claims 1-3, 6, 8, 10 and 21-24 are patentably distinct.

#### Independent Claims 1 and 8

Applicant’s independent claim 1, as amended, recites an encrypting security device that includes:

- a security photograph incorporating a multiplicity of picture elements, the security photograph having an image of an object, the object having a size, the image having a size that is greater than the size of the object;
- a scanner adapted to output a digital representation of the security photograph;
- and
- a software program that is adapted to convert the digital representation of the security photograph into an encrypted passkey that is stored within the encrypting security device, and further adapted to automatically match the encrypted passkey to the digital representation of the security photograph for allowing access to an associated apparatus.

Applicant’s independent claim 8, as amended, recites a method of securing access to an apparatus that includes:

- taking a photograph of an object using a microscope to produce an enlarged photograph of the object;
- scanning the enlarged photograph to produce a digital representation of the enlarged photograph;

executing a software program to convert the digital representation of the enlarged photograph into an encrypted passkey that is stored within the encrypting security device; and

initializing the software program to automatically recognize a subsequent scan of the enlarged photograph and automatically match the recognized scan to the encrypted passkey for allowing access to the apparatus.

The combination of Williams and Kaplan neither discloses nor suggests an encrypting security device as recited, having a software program a software program that converts a digital representation of a security photograph into an encrypted passkey, stores encrypted passkey, automatically matches the encrypted passkey to the digital representation of the security photograph and allows access to an associated apparatus as required by amended independent claims 1 and 8.

In asserting obviousness of the invention as claimed in independent claims 1 and 8, the Examiner refers to col. 2, ll. 18-40 of Williams and portions of columns 4, 8, 12 and 15 of Kaplan. The cited sections of Williams generally relate to a system for identifying the image of the face of a person as well as the image of that person's face badge and transmitting both images to a guard who, upon confirming that the real face matches the face on the badge, grants the person access to a secure area. The cited sections of Kaplan generally relate to a system for micro-etching the girdle of a cut gemstone (e.g., a diamond) with a solid state laser for positive identification and certification of the gemstone. In contrast, Applicant's invention generally relates to a system for automatic security access by creating an encrypted passkey from a photograph and then, when access is desired, automatically comparing the passkey to the photograph.

The system of Williams involves a dual camera or scanning apparatus. The first camera/scanner transmits the image of a person who is standing in visual proximity to the Williams system. The image of the person is transmitted to a guard at a remote location to the person. The second camera/scanner transmits the image of a face badge to the same guard simultaneous with the image of the person's face. If the guard determines that the two images match the same person (presumably the person standing there, desiring access), then the guard provides that person access to a secured area. (See, Williams, Abstract).

Applicant's claimed invention, by contrast, uses a software program to automatically provide access to a secured area. Williams requires the manual operation by the security guard to grant access. Applicant's claimed invention uses the details and uniqueness inherent in the

multiplicity of picture elements of an enlarged photograph of an object to create a stored encrypted passkey using the digital representation of the scanned photograph. Williams nowhere suggests creating or storing any kind of encrypted passkey. Applicant's encrypted passkey is used to automatically provide access to the secured area when it matches a subsequent scan of the security photograph. Williams uses two parallel cameras/scanners to provide the guard with both images simultaneously for comparison purposes and does not store one image (as an encrypted passkey) for subsequent automatic comparison.

For at least the reasons presented above, Applicant requests the withdrawal and reconsideration of the claim rejections for independent claims 1 and 8. Applicant respectfully submits that independent claims 1 and 8, as amended, are in a condition for allowance and respectfully requests a Notice to that effect.

#### Dependent Claims 2, 3, 6 and 10

Dependent claims 2, 3 and 6 ultimately depend from independent claim 1 and dependent claim 10 ultimately depends from independent claim 8. The allowability of dependent claims 2, 3, 6 and 10 thus follows from the allowability of independent claims 1 and 8; as such, dependent claims 2, 3, 6 and 10 are allowable over the art of record.

Therefore, for at least these reasons, Applicant submits that dependent claims 2, 3, 6 and 10 are in a condition for allowance, and respectfully request a Notice to that effect.

#### Independent Claim 21

Applicant's independent claim 21, as amended, recites a security system that controls access to a secured element that includes:

- a medium having an image of an object, the object having a size, the image having a size that is greater than the size of the object;

- a scanner that scans the medium to generate a digital representation of the image; and

- a processor connected to the scanner that converts the digital representation of the image into an encrypted passkey that is stored within the security system and grants access to the secured element when the digital representation matches the encrypted passkey, and denies access to the secured apparatus when the digital representation fails to match the encrypted passkey.

The combination of Piosenka and Kaplan neither discloses nor suggests a security system that controls access to a secured element as recited, having a processor connected to the scanner that converts the digital representation of the image into an encrypted passkey that is stored within the security system and grants access to the secured element when the digital representation matches the encrypted passkey, and denies access to the secured apparatus when the digital representation fails to match the encrypted passkey as required by amended independent claim 21.

In asserting obviousness of the invention as claimed in independent claim 21, the Examiner refers to fig. 1 and the Abstract of Piosenka and portions of columns 4, 8, 12 and 15 of Kaplan. The cited figure and section of Piosenka generally relate to a system for identifying a user of a system by comparing a portable memory that contains digital information relating to physically immutable characteristics of a user of a system with that persons real-time, scanned physical characteristic. The Piosenka system uses this comparison to allow access to a remote site. The cited sections of Kaplan generally relate to a system for micro-etching the girdle of a cut gemstone (e.g., a diamond) with a solid state laser for positive identification and certification of the gemstone. In contrast, Applicant's invention generally relates to a system for automatic security access by creating an encrypted passkey from a photograph and then, when access is desired, automatically comparing the passkey to the photograph.

The system of Piosenka involves a portable memory device and a camera/scanner. The portable memory device contains an encrypted version of a user's physically immutable identification credentials that the Piosenka reads. The camera/scanner inputs the live version of the same physically immutable identification credential of the user into the system. If the portable memory version of the credential matches the live version, then the user is granted access to a remote site. (See, Piosenka, Abstract and Figure 1).

Applicant's claimed invention, by contrast, uses the details and uniqueness inherent in an enlarged image of an object to create a locally-stored encrypted passkey using the digital representation of the image. Piosenka nowhere suggests locally storing any kind of encrypted passkey that represents an enlarged image of an object. Applicant's encrypted passkey is used to automatically provide access to the secured area when it matches a subsequent scan of the image.

Piosenka uses parallel external sources to provide the inputs for comparison and does not store one image (as an encrypted passkey) for subsequent automatic comparison.

For at least the reasons presented above, Applicant requests the withdrawal and reconsideration of the claim rejections for independent claim 21. Applicant respectfully submits that independent claim 21, as amended, is in a condition for allowance and respectfully requests a Notice to that effect.

#### Dependent Claims 22-24

By this amendment, dependent claim 22 has been cancelled and thus, its rejection has been rendered moot.

Dependent claims 23 and 24 ultimately depend from independent claim 21. The allowability of dependent claims 23 and 24 thus follows from the allowability of independent claim 21; as such, dependent claims 23 and 24 are allowable over the art of record.

Therefore, for at least these reasons, Applicant submits that dependent claims 23 and 24 are in a condition for allowance, and respectfully request a Notice to that effect.

#### **Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge fees that may be required relative to this application, or credit any overpayment, to our Account 50-2213, Order No. 075500-0265915.

Respectfully submitted,

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